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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte AN SHUN HUANG, BELKIS AKPINAR,
and CARLOS MACKU

Appeal 2006-003238
Application 09/738,656
Technology Center 1700

Decided: April 13, 2010

Before CHARLES F. WARREN, PETER F. KRATZ, and
LINDA M. GAUDETTE, *Administrative Patent Judges*.

GAUDETTE, *Administrative Patent Judge*.

DECISION ON APPEAL

Appellants appeal under 35 U.S.C. § 134(a) from the Examiner's decision finally rejecting claims 1-25 (Final Office Action ("Final"), mailed Dec. 19, 2002, 1), the only claims pending in the Application. (Appeal Brief ("Br."), filed Mar. 8, 2006, 2.) We have jurisdiction under 35 U.S.C. § 6(b).

The Examiner maintains (Examiner's Answer ("Ans."), mailed May 26, 2006, 3-5), and Appellants request review of (Br. 5), the following grounds of rejection¹:

1. claims 1, 8, 15, 19, 21, and 23² under 35 U.S.C. § 112, second paragraph, as indefinite; and
2. claims 1-25 under 35 U.S.C. § 103 as unpatentable over Haynes (US 4,707,365, issued Nov. 17, 1987) in view of Cookies Recipes (Original Chocolate Chip Cookie Recipes, 1997-1998).

For the reasons explained below, we reverse the first ground of rejection, but sustain the second ground of rejection. Therefore, the Examiner's decision is AFFIRMED.

The claimed invention is directed to cookies having improved flavor shelf life and a process for preparing them. Independent claims 1, 15, and 21 are directed to the process and independent claims 8, 19, and 23 are directed to the product. (Br. 2.) The remaining claims on appeal are dependent claims.

The standard for assessing the flavor and texture profiles of a cookie is based on the characteristics of fresh, home-baked cookies. (*See Spec.* 1:14-15; Haynes, col. 1, ll. 10-11.) Staleness is often associated with a change in flavor and/or aroma (*Spec.* 1:16-17.) For example, the vanilla,

¹ The rejection of claims 1, 8, 15, 19, 21, and 22 under 35 U.S.C. § 112, first paragraph, has been withdrawn. (Advisory Action mailed Mar. 31, 2003, 2; Ans. 2.)

² The Examiner identifies claim 22 as subject to this ground of rejection. It appears, however, that the Examiner intended to reject claim 23 as the limitations identified as being indefinite are in the independent claims (1, 8, 15, 19, 21, and 23).

butter, and dairy cream flavor and aroma notes associated with the base cake portion of freshly-baked cookies are significantly lost or diminished as time progresses due to mechanisms such as evaporation, creating a perception of staleness in the cookies prior to the end of the desired shelf life. (*See Spec. 1-3.*)

Flavor and aroma are provided to cookies through the components of the dough, e.g., butter and sugar, and by addition of flavor and aroma sources such as vanilla, essential oils, and synthetic flavors and aromas. (*Spec. 2:12-20.*) Specific chemical compounds are associated with the flavors and aromas indicative of freshness in a cookie. (*See Spec. 10:13-11:9.*) At the time of Appellants' invention, it was known that the presence and concentration of these compounds in a cookie could be detected using instrumentation such as a gas chromatograph. (*Spec. 10:17-19; Br. 13; cf. Haynes, col. 2, ll. 9-11 and col. 6, l. 48-col. 7, l. 35.*) The use of expert flavor panels to evaluate flavor and aroma was also known in the art at the time of Appellants' invention. (*Spec. 10:17-19; Br. 13-14.*) According to the Specification, at the time of the invention, an expert flavor panel would have been capable of recognizing the presence of a flavor composition, if employed in an effective flavoring amount, and would recognize when the composition was present in an amount which exceeded the normal concentration in a freshly-baked chocolate chip cookie. (*See Spec. 11:10-13.*)

Appellants' invention is "based on the research finding that the loss of freshness perception, which happens routinely during storage of commercially baked and distributed cookies, can be corrected by supplying flavor stores of freshness flavors to included chips for slow release." (*Br. 8,*

1st para.) More specifically, Appellants contend that by dispersing chips with high concentrations of added flavors within cookie dough prior to baking, they obtain cookies having a longer-lasting, freshly-baked cookie flavor by comparison to cookies made using conventional formulations. (Spec. 8:1-8.) Appellants refer to these chips as “enhanced flavor chips” and indicate that the term “enhanced” means that the concentration of added flavor in these chips is “greater than present in at least one of the base cake or [other] chips” in the dough (Spec. 10:1-3), for example, two times the concentration of flavor employed in the other chips (Spec. 10:8-9) or in conventional chocolate chips (Spec. 11:13-15). The term “flavor chip” is described as including “chocolate chips, butterscotch chips, caramel chips and any other flavored chip that is characterized by a substantially continuous fat phase, having dispersed therein a sweetener, such as a sugar and/or intensive sweetener, and flavor components such as butterscotch and ground cocoa typically supplied as cocoa liquor.” (Spec. 8:10-14.)

Claims 1 and 23 are representative of Appellants’ claimed invention and are reproduced below from the Claims Appendix to the Appeal Brief:

1. A process for preparing cookies containing chips in a basecake which is subject to diminished fresh flavor after storage, the cookies being formulated to have an extended shelf life, comprising:

preparing a cookie dough for baking into a basecake; and

adding to the dough a mixture of chips comprising sugar in a fat matrix, and at least some of said chips are enhanced flavor chips comprising at least one added flavor composition which extends fresh-baked cookie flavor otherwise diminished by storage in a concentration greater than present in the basecake and other of said chips, to supply to the basecake during storage over time at least one flavor composition effective to extend freshness perception for the cookie basecake.

23. A cookie containing chips in a basecake, which is subject to diminished fresh flavor after storage, the cookies being formulated to have an extended shelf life, comprising: a continuous cookie base cake having dispersed therein a mixture of chips of different sizes, some small and some larger, and at least some of said small chips comprising at least one flavor in a concentration greater than normally employed in flavor chips, to supply to the basecake during storage over time at least one flavor composition effective to extend freshness perception for the cookie basecake.

The Specification states that the flavor composition included in the enhanced flavor chips may be a buttery flavor, vanilla flavor, or “other flavor[] associated with freshness.” (Spec. 10:13-16.) Although “chocolate flavor” is not explicitly identified as a flavor associated with freshness, at the time of Appellants’ invention, it was known that chocolate flavor transfer from a chocolate chip to the base cake has a negative effect on consumer acceptability. (*See* Spec. 3:16-29 (citing US 4,732,767); Haynes, col. 1, ll. 35-49 (noting that “[t]he desorbed flavor compounds present in the cookie crumb have been found not to provide much of a chocolate flavor impact”).)

Haynes is directed to “overcom[ing] the problem of lost chocolate flavor impact for chocolate products, such as chocolate chips, which are used in baked goods, such [as] cookies” (col. 2, ll. 33-36). Haynes employs a “chocolate flavor system” in which cocoa solids are present in higher than their normal levels. (Haynes, col. 4, ll. 35-38.) Chocolate chips formulated using Haynes’ chocolate flavor system additionally comprise a confectionary fat, a sugar or a sugar alcohol, emulsifiers, and optional ingredients. (Haynes, col. 7, ll. 44-47.) According to Haynes, the chocolate chips have a desirable chocolate flavor impact over time even when used in baked goods such as cookies. (Haynes, col. 2, ll. 42-47.)

The Examiner finds that the chocolate chips formulated by Haynes for use in cookies are “enhanced flavor chips” (or “chips comprising at least one flavor in a concentration greater than normally employed in flavor chips”) within the meaning of Appellants’ claims. (Ans. 6, ll. 17-18; *see also*, Ans. 3.)

The Examiner further finds that the Cookies Recipes disclose the use of more than one size and/or flavor of chips in a cookie. (Ans. 4.) The “Kitchen Sink Chip” cookie described on page 4 of Cookies Recipes includes milk chocolate mini baking chips and regular white and milk chocolate chips.

*Rejection of claims 1, 8, 15, 19, 21, and 23 under
35 U.S.C. § 112, second paragraph, as indefinite*

The issue presented for our review with respect to the rejection under 35 U.S.C. § 112, second paragraph, is: has the Examiner correctly concluded that the Specification fails to provide sufficient guidance as to the meaning of the claim terms “freshness perception” and “fresh flavor,” and how these qualities are evaluated, such that the scope of the claims would not be understood by one of ordinary skill in the art? (*See* Ans. 5.)

We answer this question in the negative in light of the persuasive arguments advanced by Appellants. (*See* Br. 13-14.)

A claim satisfies the definiteness requirement of 35 U.S.C. § 112, second paragraph, when one skilled in the art understands the claim parameters as read in light of the specification. *BJ Servs. Co. v. Halliburton Energy Servs.*, 338 F.3d 1368, 1372 (Fed. Cir. 2003) (quoting *Union Pac. Res. Co. v. Chesapeake Energy Corp.*, 236 F.2d 684, 692 (Fed. Cir. 2001)) (“The definiteness inquiry focuses on whether those skilled in the art would

understand the scope of the claim when the claim is read in light of the rest of the specification.”)).

Although the terms “freshness perception” and “fresh flavor” are not explicitly defined in the Specification, it is apparent from the Specification and prior art that these terms refer to the characteristics of fresh, home-baked cookies. (*See supra* p. 2 (citing Spec. 1:14-15; Haynes, col. 1, ll. 10-11).) Moreover, one of ordinary skill in the art would understand that objective evaluation of these characteristics is possible using an expert taste panel or instrumentation such as a gas chromatograph. (*See supra* p. 3 (citing Spec. 10:17-19 and 11:10-13).)

Accordingly, we do not sustain the Examiner’s rejection under 35 U.S.C. § 112, second paragraph.

*Rejection of claims 1-25 under 35 U.S.C. § 103 as
unpatentable over Haynes in view of Cookies Recipes*

In addition to Appellants’ general traversal of this ground of rejection, Appellants contend that claims 3-5, 8-20, and 23 are separately patentable based on “limitations to chip size differentiation in addition to flavor enhancement in the smaller . . . chips.” (Br. 15.) Appellants do not present separate arguments in support of patentability of any particular independent claim. (*See* Br. 14-16.) Therefore, we decide the appeal as to this ground of rejection on the basis of independent claim 23 which contains both of the separately argued limitations. The remaining claims stand or fall with claim 23.

The Examiner determined that it would have been obvious to have prepared a cookie containing both regular chocolate chips and Haynes’ “chips comprising at least one flavor in a concentration greater than

normally employed in flavor chips” (i.e., “enhanced flavor chips”), and that it would have been obvious to have used different sizes of chips. (Ans. 3-5.) The Examiner concluded that the proposed combination would have inherently resulted in Appellants’ claimed cookie. (See Ans. 6-7 (“Thus, when a combination of such chips is used; the flavor of one chip will be enhanced over the other chips.”).)

Appellants argue, in general, that “no reference teaches the proposed combination claimed and the invention is productive of an unexpected result.” (Br. 15.) Appellants also argue “[t]here is no motivation for using different flavor concentrations in specific of [sic] differently sized chips for any purpose.” (Br. 15.)

Based on Appellants’ arguments in the Appeal Brief, the issue we consider is: does a preponderance of the evidence, taking into account any evidence of unexpected results, weigh in favor the Examiner’s conclusion of obviousness as to appealed claim 23? We answer this question in the affirmative for the reasons explained below.

Where . . . the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to prove that the prior art products do not necessarily or inherently possess the characteristics of his claimed product. Whether the rejection is based on ‘inherency’ under 35 U.S.C. § 102, on ‘prima facie obviousness’ under 35 U.S.C. § 103, jointly or alternatively, the burden of proof is the same, and its fairness is evidenced by the PTO’s inability to manufacture products or to obtain and compare prior art products.

In re Best, 562 F.2d 1252, 1255 (CCPA 1977) (citations omitted); *see also*, *In re Spada*, 911 F.2d 705, 708 (Fed. Cir. 1990).

The Examiner's factual findings (Ans. 3-5) are supported by the applied prior art disclosures. (*See supra* pp. 4-6 (*e.g.*, *compare* Spec. description of enhanced flavor chips *with* Haynes' description of chips).) The Examiner provided a detailed explanation of the motivation for combining the references to achieve the claimed invention (Ans. 5, ll. 2-11), including that the ordinary artisan would have been motivated to use Haynes' enhanced flavor chips in combination with other types of chips to obtain cookies with different flavor profiles and tastes (*see* Ans. 6-7 (addressing Appellants' arguments regarding combinations of different sizes and flavors of chips)). The Examiner's proposed motivation is supported by the Cookies Recipes' explicit disclosure of using different sizes and flavors of chips (*see supra* p. 6 (citation to Ans. 4 and Cookies Recipes)).

Appellants have not explained, with any degree of specificity, why the facts and reasons relied on by the Examiner are erroneous or fail to support the Examiner's conclusion of obviousness. (*See generally*, Br. 14-16.) Appellants have not directed us to evidence which establishes that (or otherwise explained why) the Examiner's proposed combination would not have inherently resulted in a cookie as claimed in claim 23. (*Id.*) Moreover, Appellants have not identified evidence of unexpected results of the type required to establish nonobviousness for the reasons explained by the Examiner (Ans. 7-8).

For the foregoing reasons, Appellants have not convinced us of error in the Examiner's rejection of claims 1-25 under 35 U.S.C. § 103 as unpatentable over Haynes in view of Cookies Recipes. Therefore, we sustain this ground of rejection.

CONCLUSION

The Examiner's decision to reject claims 1-25 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1).

AFFIRMED

PL Initial:
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